

Docket No.: 05058/02806

#22
2203 615

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

U.S. Application of:

Takeo HODA, Dai SHINTANI, Yoshihiro
TANAKA, Hiroshi ISHIBE, Hirokazu NARUTO,
Hirokazu YAMADA, Nobuyuki TANIGUCHI and
Katsuyuki NAMBA

For:

IMAGE INFORMATION PROCESSING SYSTEM

Confirmation No.:

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U.S. Serial No.:

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Huy Thanh Nguyen

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MS NON-FEE AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **MS NON-FEE AMENDMENT**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

June 25, 2003

Date of Deposit

Douglas A. Sorensen

Name of Applicant, Assignee, or Registered Representative

Signature

June 25, 2003

Date of Signature

RESPONSE

This Response is filed in response to the Office Action dated April 8, 2003 which provides for a response period ending July 8, 2003.

Status Of Application

Claims 42-55 are pending in the application; the status of the claims is as follows:

Claims 42-49 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,737,014 to Tojo et al. ("Tojo").

Claims 42 and 44-49 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,162,833 to Taka ("Taka").

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of U.S. Patent No. 4,709,385 to Pfeiler et al. ("Pfeiler").

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Pfeiler.

Claim 43 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of U.S. Patent No. 5,034,804 to Sasaki et al ("Sasaki").

Drawings

The indication, in the Office Action, that the Examiner has approved the Request for Approval of Proposed Drawing Changes filed on January 24, 2001, is noted with appreciation.

Accordingly, formal drawings of Figs. 10, 14A, 16B, 33, 43 and 44 are submitted herewith.

35 U.S.C. § 102(e) Rejections

The rejection of claims 42-49 under 35 U.S.C. § 102(e) as being anticipated by Tojo, is respectfully traversed based on the following.

Tojo shows a system including a memory 7 contained in a memory unit 27 that plugs into a slot in imager 1 (figure 3). The system also includes an attachable recorder 2 containing a disk 20 that slides onto projection 1' and makes contact with terminals 36 for electrical communication with the imager 1. Image data stored on the disk 20 can be displayed on a monitor 10 via camera signal processing circuit 5 when switch 11 is in the 'a' position. Image data on memory 7 can be displayed on monitor 10 through D/A converter 9 when switch 11 is in the 'b' position. However, in Tojo, the disk 20 is mounted in the disk recorder 2 and is not included inside of imager 1, where memory 7 and monitor 10 are installed.

In contrast to the cited prior art, claim 42 includes:

- a first memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed inside the camera body, to selectively receive and reproduce image information recorded on one of the first memory and the second memory...

As stated in Applicants' prior response, Tojo does not show or suggest a device where the first and second memories are installed inside the camera body. Disk 20 is clearly installed in recorder 2, which is separate from the imager. In response to this, the Office Action states:

[I]t is noted that Tojo teaches that the first memory and second memory are installed in a camera body since the recorder 2 can be attached to the image pick up apparatus to form a camera apparatus having a body and the first memory and second memory are installed inside the camera body.

This reasoning does violence to logic and the plain meaning of the claim. The Office Action states that the first and second memories are installed inside the body because the recorder 2 can be attached to the side of imager 1. If the Examiner can simply redefine "body" to encompass any attachable device, there would be no such thing as a memory installed outside of the body. This interpretation renders the phrase "installed

inside the camera body" meaningless because virtually any device will be attached in some way.

In essence, the Examiner has ignored the limitation "installed inside the camera body" by interpreting camera body include to anything that may be physically attached to the camera body. However, every limitation of a claim must be considered. MPEP §2131. An express limitation of the claim cannot be ignored simply by using an unreasonable interpretation of part of that limitation. By any reasonable interpretation of Tojo, the camera body consists of imager 1. Recorder 2 is an attachment to the camera body. Imager 1 can function as a camera without recorder 2. Thus, every element necessary for camera functionality is contained in imager 1. Recorder 2 simply provides additional storage for image data. Therefore, the only reasonable interpretation of Tojo is that imager 1 is a separate camera body and recorder 2 is an attachment thereto. Thus, Tojo does not show or suggest a first and second memory installed in the camera body.

To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, Tojo does not anticipated claim 42. Claims 43-46 are dependent on claim 42 and thus include every limitation of claim 42. Therefore, the Tojo patent does not anticipate claims 43-46.

Also in contrast to the cited prior art, claim 47 includes:

- a first connection electrically connectable to a first recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second connection electrically connectable to a second recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed in the camera body, to selectively reproduce image information stored on one of the first recording medium and the second recording medium...

As noted above, Tojo does not show or suggest a device where the first and second memories are mounted inside the camera body. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, Tojo does not

anticipate claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, Tojo does not anticipate claims 48 and 49.

Accordingly, it is respectfully requested that the rejection of claims 42-49 under 35 U.S.C. § 102(e) as being anticipated by Tojo, be reconsidered and withdrawn.

Claims 42 and 44-49

The rejection of claims 42 and 44-49 under 35 U.S.C. § 102(e) as being anticipated by Taka, is respectfully traversed based on the following.

The Taka patent shows an arrangement comprising the recall memory 10, the special memory 12, and the image display device 18. However, it is not clear whether these devices 10, 12 and 18 are installed inside the camera body 20. Camera body 20 is shown as a separate element from recall memory 10 and special memory 12 in Figure 1. Camera body 20 is shown in Figure 2, but recall memory 10 and special memory 12 are not. The Taka patent states at column 3, lines 32-36 that:

FIG. 1 shows in block diagram the arrangement of all devices of a practical example of the still camera equipped with an electronic imaging device, to which the invention is applied. The outer appearance of this camera is partly shown in FIG. 2.

Further, Taka states at column 4, lines 18-20 that a "camera body 20 whose outer appearance is shown in FIG. 2 has display device 18" In other words, Taka states that FIG. 1 shows the entirety of the still camera and that FIG. 2 shows the camera body 20, which is a separate element in FIG. 1. Display devices 18 and 26 are shown as part of the camera body 20, but there is no discussion as to which of the other components of FIG. 1 are included. It is not clear whether the recall memory 10 and the special memory 12 are arranged inside or outside of the camera body 20.

In contrast to the cited prior art, claim 42 includes:

- a first memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second memory, installed inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed inside the camera body, to selectively receive and reproduce image information recorded on one of the first memory and the second memory...

The Taka patent is indefinite as to the position of the recall memory and the special memory, and thus does not show or suggest a device where the first and second memories are installed inside the camera body.

In response to this argument, the Office Action states on Page 8:

It is noted that Figs. 1 and 2 in Taka reference illustrate the circuits inside the camera. The circuits include a first memory and a second memory (recall memory and special memory)(column 4-4). Fig. 2 Taka further teaches the operative buttons mounted on the camera body to control the first memory and second memory are inside the body of the camera.

There is absolutely nothing in Taka to support this statement. The outer appearance of the camera is only partly shown in Figure 2 (column 3, lines 35-36). Taka specifically states that Figure 2 shows camera body 20 (column 4, lines 18-20). In addition, image display device 18, counter display device 26, image pickup means 2 and several buttons (REL, DWN, UP, RCL, SPC and STP) are specifically shown in Figure 2. **Recall memory 10 and special memory 12 are shown as separate elements from camera body 20 in Figure 1.** This directly contradicts the statement quoted above. Other than showing recall memory 10 and special memory 12 as separate elements in the schematic diagram of Figure 1, there is absolutely no disclosure in Taka concerning the physical positioning of these memories. Any statement about the physical position of recall memory 10 and special memory 12 is simply speculation. Thus, contrary to the statement quoted above, Taka does not show or suggest a first and second memory

installed in a camera body, but rather Taka shows two memories used with a camera body with no suggestion as to where those memories are physically located.

To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, Taka does not anticipate claim 42. Claims 44-46 are dependent on claim 42 and thus include every limitation of claim 42. Therefore, Taka does not anticipate claims 44-46.

Also in contrast to the cited prior art, claim 47 includes:

- a first connection electrically connectable to a first recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a second connection electrically connectable to a second recording medium, mounted inside the camera body, capable of storing image information corresponding to a plurality of photographic frames;
- a reproduction device, installed in the camera body, to selectively reproduce image information stored on one of the first recording medium and the second recording medium...

As noted above, Taka does not show or suggest a device where the first and second memories are mounted inside the camera body. To provide anticipation, a reference must show, expressly or inherently, every element of the claim. Therefore, Taka does not anticipate claim 47. Claims 48 and 49 are dependent on claim 47 and thus include every limitation of claim 47. Therefore, Taka does not anticipate claims 48 and 49.

Accordingly, it is respectfully requested that the rejection of claims 42 and 44-49 under 35 U.S.C. § 102(e) as being anticipated by Taka, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

The rejection of claims 50-55 under 35 U.S.C. § 103(a), as being unpatentable over Tojo in view of Pfeiler, is respectfully traversed based on the following.

The Pfeiler patent shows a system including a third image memory 12. The third image memory 12 is adapted to supply a signal from the differencing unit 11 to the display 14 via the A/D converter 13. Although Pfeiler does not clearly recite the specific function of the differencing unit 11, it is presumed through the specification and the drawings that the differencing unit 11 is adapted to obtain a difference signal between a signal from the first image memory 8 (or from the second image memory 9) and a signal from the A/D converter 6 (*i.e.*, image information that has been photographed by the video camera 5). Thus, neither the information recorded in the third image memory 12 nor the image displayed on the display 14 corresponds to the information stored in the first image memory 8 and the second image memory 9. In other words, the third image memory 12 of Pfeiler is not an element for temporarily storing information that has been stored in the first image memory 8 and the second memory 9 prior to display, but is an element adapted for temporarily storing information that is different from the information stored in the first image memory 8 and the second image memory 9 after that information has been created by the differencing unit.

In contrast to the cited prior art, claim 50 includes:

a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, via **the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device**, and a second condition, in which image information on the second memory is outputted to the reproduction device via **the internal memory so that the image information recorded on the second memory is reproduced as an image by the reproduction device**.

As noted above, Pfeiler does not show the use of a memory for temporarily storing the image information store in memory 8 or 9, but rather memory 12 is used to store the output of differencing unit 11. Thus, Tojo and Pfeiler, even when combined, do not show or suggest every limitation of claim 50.

In response to this argument, the Office Action states:

The image signal from either first or second memory is selected to the reproducing device and Pfeiler teaches electrical connections between the first memory and second memory and the image from either the first memory or second memory is provided to memory processing and the image from the memory forwarded to a reproducing device for displaying the images. Further it is noted that the memory taught by Pfeiler is considered as a buffer for temporary storing the images since the image from the first memory or second memory is stored in the memory and then is forwarded to a display device for displaying.

This statement is incorrect in that the image from the first or second memory is never transferred to the image memory 12 in Pfeiler, only the results of the differencing unit. The only connection between image memories 8 and 9 is via differencing unit 12. The only time the image information would be transferred without alteration is when there is no output of A/D converter 6.

The claim limitation reads that image information "**on the first memory**" is provided "via the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device." This limitation requires that the image information on the first or second memories, not some derivation of this image information, be applied to the reproduction device via the internal memory.

Apparently, the Examiner has somehow modified the image memory 12 into a buffer memory. However, to modify a reference for the purposes of a *prima facie* case for obviousness, a suggestion for the modification must be shown in the references or other prior art. MPEP §2143.01. The Examiner has apparently modified the image memory 12 in Pfeiler from a memory for the storage of results of the differencing unit 11 into a buffer memory, but has provided no suggestion for this modification. Even if such a modification were suggested, there is no suggestion in the cited references to insert an additional memory into the circuit of Tojo. There is nothing in Tojo indicating that such a modification would be necessary, desirable or useful. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 50. Any claim that is dependent

on a nonobvious claim is also nonobvious. MPEP §2143.03. Therefore, claims 51-53 are also nonobvious.

Also in contrast to the cited prior art, claim 54 includes:

a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication **via the internal memory so that the image information recorded on the first recording medium is reproduced as an image by the reproduction device**, and a second condition, in which the reproduction device and the second connection are placed in communication **via the internal memory so that the image information recorded on the second recording medium is reproduced as an image by the reproduction device**.

As noted above, Tojo fails to teach or suggest the use of a memory for temporarily storing the image signal and Pfeiler does not show the use of a memory for temporarily storing the image information stored in another memory, but rather memory 12 is used to store the output of differencing unit 11. Thus, the Tojo and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 54. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 54. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claim 55 is also nonobvious.

Claims 50-55

Claims 50-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Pfeiler is respectfully traversed based on the following.

In contrast to the cited prior art, claim 50 includes:

a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the reproduction device, via **the internal memory so that the image information recorded on the first memory is reproduced as an image by the reproduction device**, and a second condition, in which image information on the second memory is outputted to the reproduction device

via the internal memory so that the image information recorded on the second memory is reproduced as an image by the reproduction device.

The rejection states:

[I]t is noted that the combination of Taka and Pfeiler teaches electrical connection between the first memory and second memory and the out[*sic*] from the first or second memory is forwarded to the temporary memory via electrical connection since Taka teaches electrical connections between the first memory and second memory to a reproducing device[.] The image signal from either first or second memory is selected to the reproducing device and Pfeiler teaches electrical connections between the first memory and second memory and the image from either the first memory or second memory is provided to a memory for processing and the image from the memory forwarded to a reproducing device for displaying images. Further, it is noted that the memory 12 as taught by Pfeiler is considered as a buffer for temporary storing the images since the image from the first memory or second memory is stored in the memory and then is forwarded to a display device for displaying. ... Further, it is noted that the examiner relies on Pfeiler that is being teaching the connections between the first memory and second memory and a temporary storing memory to combine with Tojo reference.

As noted above, Pfeiler does not show the use of a memory for temporarily storing the image information from another memory, but rather memory 12 is used to store the output of differencing unit 11. The Examiner has not demonstrated any suggestion in the prior art to modify the image memory 12 into a buffer memory. Even if such a modification were suggested, there is no suggestion in the cited references to insert an additional memory into the circuit of Taka. There is nothing in Taka indicating that such a modification would be necessary, desirable or useful. Thus, the Taka and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 50. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 50. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claims 51-53 are also nonobvious.

Also in contrast to the cited prior art, claim 54 includes:

a changer to selectively change between a first condition, in which the reproduction device and the first connection are placed in communication via **the internal memory so that the image information recorded on the first recording medium is reproduced as an image by the reproduction device**, and a second condition, in which the reproduction device and the second connection are placed in communication via **the internal memory so that the image information recorded on the second recording medium is reproduced as an image by the reproduction device**.

As noted above, Taka fails to teach the use of a memory for temporarily storing the image signal and Pfeiler does not show the use of a memory for temporarily storing the image information from another memory, but rather image memory 12 is used to store the output of differencing unit 11. Thus, the Taka and Pfeiler patents, even when combined, do not show or suggest every limitation of claim 54. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 54. Any claim that is dependent on a nonobvious claim is also nonobvious. Therefore, claim 55 is also nonobvious.

Accordingly, it is respectfully requested that the rejection of claims 50-55 under 35 U.S.C. § 103(a) as being unpatentable over Tojo in view of Pfeiler, be reconsidered and withdrawn.

The rejection of claim 43 under 35 U.S.C. § 103(a), as being unpatentable over Taka in view of Sakai, is respectfully traversed based on the following.

Claim 43

Claim 43 is dependent upon claim 42 and thus includes every limitation of claim 42. As noted above, with regard to claim 42, Taka is indefinite as to the position of the special memory, and thus does not show or suggest a device where the first and second memories are installed inside the camera body. The Sasaki patent merely shows the use of a single memory 15. Therefore, Sasaki also does not show or suggest a device where the first and second memories are installed inside the camera body. To support a *prima*

facie case of obviousness, the combined references must show or suggest every limitation of the claim. MPEP §2143. The Taka and Sasaki patents, even when combined, do not show or suggest every limitation of claim 43. Therefore, the cited references do not provide a *prima facie* case for obviousness of claim 43.

Accordingly, it is respectfully requested that the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over Taka in view of Sakai, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

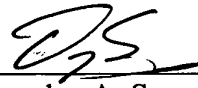
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Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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